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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/761,713	01/21/2004
		First Named Inventor	
		Pei-Yuan Lee	
		Art Unit	Examiner
		3724	Stephen Choi
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 32,512 Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/761,713 Confirmation No.: 3703
Applicant : Pei-Yuan Lee
Title : PUNCHING APPARATUS HAVING
DETACHABLE HANDLE DEVICE
Filed : January 21, 2004
TC/A.U. : 3724
Examiner : Stephen Choi
Docket No. : 3507.2.30
Customer No. : 21552

REMARKS/ARGUMENTS SUPPORTING APPLICANT'S

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This paper is submitted in response to the Advisory Action mailed April 10, 2006. In the Advisory Action, the Examiner entered, for purposes of appeal, the Amendment and Response to the Office Action that was filed by Applicants on March 3, 2006 (hereinafter "3/3/06 Amendment"). However, the Examiner did not find Applicant's arguments persuasive and maintained the prior rejection of claims 6 and 13-15 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,967,336 issued to Cutter (hereinafter "Cutter") in view of U.S. Patent No. 2,898,613 issued to Frederick (hereinafter "Frederick"). The Examiner also maintained his rejection of claim 11 under §103(a) as being obvious over Cutter, Frederick and U.S. Design Patent No. D489,763 issued to Chen (hereinafter "Chen"). However, in the Advisory Action, the Examiner also noted (and seemingly relied on) the Admitted Prior Art (hereinafter "APA") found in Figure 2(a) of the specification.

Applicant respectfully asserts that the Examiner clearly erred in maintaining the rejection of the claims because the Examiner has not established a *prima facie* case of obviousness. Specifically, the Examiner failed to establish *prima facie* obviousness because (1) all of the claimed limitations are not taught or suggested by the cited references; and (2) there is no teaching or suggestion to combine/modify the references in the manner asserted by the Examiner. Accordingly, because the Examiner has failed to establish *prima facie* obviousness, the Examiner's rejection under §103(a) is improper and must be withdrawn.

I. THE CITED REFERENCES DO NOT DISCLOSE, TEACH, OR SUGGEST ALL OF THE CLAIMED LIMITATIONS.

Independent claim 6 recites that the handle member is “attachable to and detachable from a first end and a second end of said transmitting shaft” and that the stopper likewise may be secured to a “selected one of said first end and said second end of said transmitting shaft.” Further, this claim recites that “said stopper and said handle member being exchangeably disposed at said first and said second ends of said transmitting shaft.” Dependent claims 11 and 13-16 depend from claim 6 and thus also include these claim elements. Such limitations regarding the “exchangeabl[e]” nature of the stopper and the handle member are not taught, disclosed, or suggested by Cutter, Frederick, Chen, or even Applicant’s APA.

In the 3/3/06 Amendment, Applicants argued that both Cutter and Frederick (*i.e.*, the references cited against claim 6) taught a system which has a housing that prevents the handle member and the shaft from being exchangeable¹, and as such, these reference clearly do not teach or suggest the limitations regarding the “exchangeabl[e]” nature of the stopper and the handle member. *See* 3/3/06 Amendment, pp. 4-5. In the Advisory Action, the Examiner apparently concedes the validity of Applicant’s argument:

The examiner agrees [sic] that the housing as shown on Fig. 1 of Cutter will interfere from the handle being mounted on the other end of the shaft....The examiner’s rejection relied on the teachings of Frederick for the use of a pin and holes on the handle and shaft for removably securing the handle on the shaft.

Advisory Action, p. 2. Yet, despite agreeing with Applicant on this point, the Examiner maintained the rejection of these claims on grounds that “[i]t is the examiner’s position that the modified device of Cutter teaches all the claimed structural [sic] limitations and capable of exchanging positions of the handle and stopper as claimed.” *Id.*

The Examiner has not provided any support or basis for his conclusion that the “modified device of Cutter” teaches the claimed limitations. This is legal error and does not satisfy the Examiner’s burden of establishing a *prima facie* obviousness. Specifically, in order to establish a *prima facie* case, the Examiner has the burden of showing that all of the claimed limitations are

¹ In Cutter, the housing that prevents the exchanging the stopper and the handle member is the “housing 12” that is visible in Figure 1. In Frederick, this “housing” is the “cover 15” that is shown in Figure 4.

indeed found in the prior art. *See e.g.*, MPEP § 2142. This involves identifying particular teachings or sections of the prior art which purportedly disclose or suggest the claim limitations. *See id.* Merely asserting that this limitation is taught in the prior art without any evidentiary support, as was done in the present case, does not satisfy the Examiner's burden to establish a *prima facie* case of obviousness. Without this evidentiary basis, it is clear error to reject the present claims under §103.

Applicant respectfully submits that the reason why the Examiner has not identified any specific portion or teaching in the cited prior art references regarding the "exchangeabl[e]" nature of the stopper and the handle member is because no such teaching exists in these references.² Accordingly, because these claim elements are not taught or suggested by the prior art references, there can be no finding of *prima facie* obviousness and the Examiner clearly erred in maintaining the rejection of the pending claims.

II. THE EXAMINER HAS NOT PROVIDED ANY MOTIVATION TO COMBINE

Not only do the cited references fail to teach all of the relevant claim limitations, Applicant submits that there is no teaching or motivation to combine Cutter and Frederick in the manner asserted by the Examiner. *See* MPEP § 2143.01 (III); *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"). As discussed above, both Cutter and Frederick teach systems in which a housing is positioned around the opposite end of the shaft that will prevent the handle member from being exchanged with the stopper. Given the presence of this housing, Applicant believes that there is no reason or justification of why a skilled artisan would be motivated to remove the housing and put the handle on the opposite end. On the contrary, the fact that the housing is there *teaches away* from putting the handle on the opposite end, and shows that there is no motivation to combine and no *prima facie* obviousness. *See e.g.*, *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000) (if a reference teaches away, then that finding alone can defeat a claim of obviousness), *cert. denied*, 530 U.S. 1238 (2000). Accordingly, the Examiner committed clear error in maintaining the rejection under §103.

² As recognized by the Examiner, Chen does not have any teaching regarding this limitation. Rather, the Examiner relies on Chen for its teaching of a "hexagonal post." *See* Final Office Action, p. 2.

III. THE APA IDENTIFIED IN THE ADVISORY ACTION DOES NOT COMPENSATE FOR THE CLEAR LACK OF PRIMA FACIE OBVIOUSNESS

Apparently recognizing the deficiencies in the obviousness rejection, the Examiner raised in the Advisory Action, for the first time, the APA:

The examiner notes that Applicant's admitted prior art (e.g., Fig. 2 (a)) shows an example of a housing capable of accommodating handle members (e.g., handle member and stopper) at both ends of a shaft.

Advisory Action, p. 2. The APA of Figure 2(a) shows a punching apparatus having "two handles 11 disposed on both sides P1 and P2 of the punching structure (casing 12). Specification, ¶ [0004]. While the Examiner is correct that the APA shows a housing that allows handles to be placed on both sides of the punching structure, this teaching does not make up for the deficiencies of the Examiner's rejection under §103.

First, the Examiner has not provided a teaching to combine the APA with Cutter or the other prior art references. In order to use the APA as part of the present rejection under §103, there must be "objective evidence of record" which indicates why a skilled artisan would have combined the teachings of the APA with Cutter, Frederick and/or Chen. *See In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). As the Examiner has not met the burden of showing this "objective evidence," there is no *prima facie* obviousness and the teachings of the APA cannot be used to reject the present claims. *See id.*

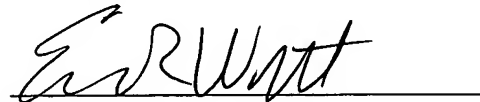
Moreover, even if the APA could be used as part of a § 103(a) rejection, the APA still does not teach or suggest the limitations discussed above regarding the "exchangeabl[e]" nature of the stopper and the handle member. On the contrary, the APA teaches a system in which there is a distinct handle on each end of the shaft. There is no teaching that such handles are exchangeable and certainly no motivation to remove and exchange the handles. As recited by Applicant's specification, the reason that the handle and the stopper are interchangeable is so that the punching apparatus may be used by left-hand and right hand users. In the APA, there is a handle at both ends, and thus, this device may also be used by left-hand and right hand users. There is absolutely no reason or need to make the handle and the stopper exchangeable because left-handed users can already easily use the system. Thus, the APA clearly does not teach the limitation that the handle and stopper are exchangeable.

Therefore, because the APA (1) cannot be used as part of an obviousness rejection and (2) does not teach the relevant claim limitations, the Examiner's apparent reliance on the APA is clear error.

IV. CONCLUSION

Because the Examiner did not show that all of the claimed limitations are taught in the art, nor did the Examiner find any teaching or suggestion to modify the references, the Examiner failed to establish *prima facie* obviousness against claims 6, 11, and 13-15. Therefore, the Examiner clearly erred in maintaining the rejection of the pending claims under §103. Consequently, Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E. R. Witt", is written over a horizontal line.

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Date: April 25, 2006

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